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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TEDDY J. HIRSCH and DON L. IVEY

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Appeal No. 1999-1037  
Application 08/804,284

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HEARD: FEBRUARY 22, 2000

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Before ABRAMS, STAAB and BAHR, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is a decision on an appeal from the examiner's final rejection of claims 1, 3, 4, 11, 12 and 15. Claims 20-22, the only other claims remaining in the application, have been allowed. An amendment filed subsequent to the final rejection on April 24, 1998 has been entered.

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Appellant's invention "relates to crushable roadway crash cushions and, more specifically, those crash cushions which contain collapsible barrels, drums or like members" (specification, page 1). Independent claims 1 and 11 are representative of the appealed subject matter. A copy of the appealed claims can be found in an appendix to appellant's brief.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Boedecker, Jr. et al. (Boedecker) 5, 1974	3,845,936	Nov.
Carney, III ('326) 1991	5,011,326	Apr. 30,
Carney, III ('112) 1995	5,403,112	Apr. 4,

A reference of record relied upon by this merits panel of the Board in support of a new rejection pursuant to 37 CFR § 1.196(b) is:

Carney, III ('310) 1980	4,200,310	Apr. 29,
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The following rejections under 35 U.S.C. § 103 are before

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us for review:<sup>1</sup>

1) claims 1, 3 and 4, unpatentable over Boedecker in view of Carney '326; and

2) claims 11, 12 and 15, unpatentable over Boedecker in view of Carney '112.

#### *Rejection 1*

Considering first the examiner's rejection of claims 1, 3 and 4 as being unpatentable over Boedecker in view of Carney '326, the examiner considers that Boedecker discloses the subject matter of claim 1 except for a structural reinforcement "comprising a telescoping bracket assembly." In particular, the examiner considers that Boedecker's sheet-like

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<sup>1</sup> In the final rejection, claims 1, 3, 4, 11, 12, 15, and 20-22 were also rejected under 35 U.S.C. § 112, second paragraph. The rejection of claims 20-22 on this ground has been expressly withdrawn. See page 2 of the answer. Regarding the rejection of claims 1, 3, 4, 11, 12 and 15 under 35 U.S.C. § 112, second paragraph, since these claims have been amended subsequent to the final rejection in such a manner so as to apparently overcome the examiner's criticisms thereof, and since no mention of this rejection has been made by the examiner in the answer, we presume that the examiner also has withdrawn the final rejection of claims 1, 3, 4, 11, 12, and 15 on this ground. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

"fish scales" 60<sup>2</sup> comprise structural reinforcement extending along a portion of a side of the crash cushion. The examiner further considers (answer, pages 3-4) that Carney '326 "teaches that it is known in the art to form a cushioning apparatus with telescoping support members (discussed in column 3 line 57 through column 4 line 2) comprising tubes viewed as a pipe segment slidably disposed within a sleeve." According to the examiner (answer, page 4), it would have been obvious to one of ordinary skill in view of these teachings to modify the bracket of the structural reinforcement of Boedecker by incorporating therein telescoping tubes comprising a pipe segment slidably disposed within a sleeve.

We cannot support the examiner's position. The disclosure of Carney '326 relied upon by the examiner is found in the "Background of the Invention" section of Carney '326 and reads as follows:

Examples of other forms of stationary energy absorbing barriers, which are known to exist in the prior art, include the following: . . . a *U-shaped*

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<sup>2</sup> As explained at column 5, line 53, through column 6, line 5, and as shown in Figures 6A-6C of Carney '326, "fish scales" 60 are composite structures, each comprising a plywood sheet 62 having a metal sheet 66 secured thereof.

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*tubular guardrail energy absorbing barrier that absorbs energy by means of the motion of supporting telescopic tubes such that upon impact, the impact forces are transmitted axially to arms, which contain many stainless steel torus elements that are squeezed between two cylindrical tubes . . . .*  
[Column 3, line 57, through column 4, line 2; emphasis added.]

There are no drawings or other detailed description of this device in Carney '326.

We have carefully considered the above noted disclosure of Carney '326. We also have considered the rest of the disclosure of Carney '326. Despite our best efforts, we simply cannot determine with any degree of certainty precisely what the device described at column 3, line 57, through column 4, line 2, might

look like. In a nutshell, the teachings of Carney at column 3, line 57, through column 4, line 2, are simply too obscure to provide a basis for establishing a *prima facie* case of obviousness of the subject matter of claim 1. More specifically, the cryptic description of "a U-shaped tubular guardrail" having "supporting telescopic tubes" that transmit

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